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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------------|-------------|----------------------|---------------------|------------------|
| 10/522,503 | 06/27/2005 | Joachim Petersen | 12834-00004-US | 1450 |
| 23416 | 7590 | 05/11/2006 | EXAMINER | |
| CONNOLLY BOVE LODGE & HUTZ, LLP | | | BOYKIN, TERRESSA M | |
| P O BOX 2207 | | | ART UNIT | PAPER NUMBER |
| WILMINGTON, DE 19899 | | | 1711 | |

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------|-----------------------------------|--|
| Office Action Summary | Application No. 10/522,503 | Applicant(s) PETERSEN, JOACHIM | |
| | Examiner Terressa M. Boykin | Art Unit 1711 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>1/26/05</u> | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

Applicant's arguments filed 3-3-06 have been fully considered but they are not persuasive.

Applicants' claim 1 etc. remains so broadly set forth that the claim continues to be interpreted by the Examiner as anticipated by the references while remaining within the scope of the specification. It should be noted that in order to prosecute the case resourcefully and expediently while giving the applicants the best possible search, it is imperative and practical for the applicants to clarify how the process would differ from the claimed invention by how the film is arranged/incorporated/formed or structured therein.

Without such clarity of structure, the art of record remains within the scope of the present claims and the applicants' arguments although understood and appreciated are moot on those basis. The manner in which the process as claimed is set forth, remains so vastly broad that it may be anticipated by the reference while still remaining within the scope of the specification. Note further a process should at least recite clear, active steps and any process parameters necessitated by the specification so that the claim will "clearly set out and circumscribe a particular area with a reasonable degree of precision and particularity, In re Moore, 169 USPQ 236, and make it clear what subject matter the claim encompasses, as well as makes clear the subject matter from others would be precluded. In re Hammack 166 USPQ 204.

Thus, applicants have not satisfactorily demonstrated how the claims are not anticipated (or rendered obvious) over the reference.

It would be beneficial for the applicants to use language from the specification to further specify the claimed language without, of course, unfairly limiting applicants intended invention.

35 USC 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over by USPub 20040186189 see pages 1-4.

USPub 20040186189 discloses a method for producing polymer-electrolyte membranes using plasma-assisted deposition in a gaseous phase. Said method simplifies the process in relation to prior art by the selection of its starting materials, carbon or fluorocarbon compounds and water. The reference also relates to a polyazol membrane coated by plasma-polymerization. The purpose of the method is to produce polymer films, the polyazole is, in a further step, dissolved in polar, aprotic solvents such as dimethylacetamide (DMAc) and a film is produced by classical methods. Thus, the **USPub 20040186189** reference discloses a treatment for polyazole films prepared from the same components as claimed by applicants except for the function

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wherein the film is unrolled from a spool and rolled upon a further spool.

However, the function wherein a film, which is unrolled from one spool and wound onto another is well understood by persons skilled in the art for centuries. See **USP 1375815** col. 2 lines 108 to col. 3 line 1. The treatment or processing of a film in the interim of rewinding is also well documented. US 5965485 discloses a process wherein there is a second rewinding step, wherein the rolled layer is unrolled and rewound around the ribbon spools while sequentially changing a roll diameter thereof. This procedure causes the change in contact position between the ink layer and the back coat layer, so that there arises a phenomenon that the dyes transferred to the back coat layer from the ink layer in the first step is re-transferred to the image-protective layer when rewound in the second step. Thus, although the process of treatment may vary, the process of "treating" a film while/during the changing of the film from one roll to another spool is well known. It would have been obvious to one having ordinary skill in the art at the time the invention was made to treat/process a film particularly the polyazole film above since the process or function is well-known to the skilled artisan. Consequently, the claimed invention cannot be deemed as unobvious and accordingly is unpatentable.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over by USPub 20040186189 see pages 1-4 further in view of USP 2005/0058771.

Applicants argue that the prior art does not demonstrate a

".....feature that is not disclosed in Muller is wherein the direction of travel of the film is changed during the treatment by altering the direction of rotation of the spools."

Note that the film-handling embodiment of the reference which is depicted in

FIGS. 6 and 7, wherein apparatus 10 includes film supply spool 12 and film take-up spool 12'. Spool 12 feeds a strip of film 30 on which a bead 40' of conductive paste is applied to the lower film surface by a nozzle 16. Nozzle 16 is connected to a source of the conductive paste (not shown). In an alternate embodiment, shown in phantom lines, an idler roller 14 changes the direction of film 30' so that conductive bead 40", is applied to the film at a higher angle with respect to the surface of stencil mask 50.

This is not an uncommon and especially unobvious feature.

It would have also been obvious in addition to the aforementioned to one having ordinary skill in the art at the time the invention was made to treat/process a film film above since the process of changing film direction over a roller or spool is well known to the skilled artisan.

Again, it is reiterated that it would be beneficial for the applicants to use language from the specification to further specify the claimed language without, of course, unfairly limiting applicants intended invention.

Consequently, the claimed invention cannot be deemed as unobvious and accordingly is unpatentable.

Correspondence

Please note that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov <<http://www.uspto.gov>>), from the Office of Public Records and from commercial sources. Applicants may be referred to the Electronic Business Center (EBC) at <<http://www.uspto.gov/ebc/index.html>> or 1-866-217-9197.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Terressa Boykin whose telephone number is 571 272-1069. The examiner can normally be reached on Monday through Friday from 6:30am to 3:00pm.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. The general information number for listings of personnel is (**571-272-1700**).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tmb


Examiner Terressa Boykin

TERRESSA M. BOYKIN
PRIMARY EXAMINER